

It appears that the process being claimed in claim 1 would not be used for the oxidation of the carbon monoxide and volatile organic compounds as applicants claiming in claims 23 & 24. It might be that applicants intend to recite the catalyst produced by the process of claim 1 is used for the oxidation of carbon monoxide and volatile organic compounds, but the claims do not particularly point out so.

In response thereto, Applicants have amended claims 23 & 24 to more clearly recite the subject matter in these claims. Specifically, claim 23 now recites "The process of claim 1, wherein the catalyst formed by said process is used for the oxidation of carbon monoxide," and claim 24 recites "The process of claim 1, wherein the catalyst formed by said process is used for the oxidation of volatile organic compounds."

Based on the above, Applicant respectfully contends that amended claims 23-24 conform with the requirements of 35 U.S.C. 112 second paragraph, and accordingly request that the rejection under 35 U.S.C. 112, second paragraph be reconsidered and withdrawn.

Rejection Under 35 U.S.C. 103:

Claims 1-24 are rejected under 35 U.S.C 103(a) as being unpatentable over Wood et. al, taken together with Hinson.

The Examiner noted, inter alia, that:

The difference between the process disclosed by Wood and the claimed process, is that the process disclosed by Wood does not include step (d), which is etching of the coated substrate.

However, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the etching step into the process of Wood in order to obtain an improved catalyst having a roughened metal surface, in view of the advantage taught by Hinson, that etching of the coated metal surface is to remove the coating and to achieve controlled, reproducible, and desired levels of surface roughness, and able to achieve high levels of surface roughness (see Hinson at col 3, ln 25-41).

37 C.F.R. 1.131 allows for a patent cited against an application to be overcome by an affidavit or declaration of prior invention. The oath must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication (§1.131(a)(1)) In

the instant case, Applicant has provided an affidavit showing the completion of the invention well before the filing date of the cited patent.

Section 1.131(b) requires that the showing of facts must establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. Applicant has furnished photocopies of applicable pages from a NASA-LaRC Research Notebook which supports the contention that the instant invention was reduced to practice in the laboratory well before the filing date of the Wood reference on December 16, 1997.

The examiner noted that "the difference between the process disclosed by Wood and the claimed process is that the process claimed by Wood does not include ... etching of the coated substrate [which] would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have incorporated this etching step into the process of Wood ... in view of the advantage taught by Hinson..." However, it is respectfully submitted that Wood does not constitute prior art over the instant application.

Section 1.131(a)(1) informs that when an appropriate declaration has been advanced, the cited patent shall not bar the grant of patent to the Applicant or confirmation of the patentability of the claims. The elimination of Wood as a bar to patentability renders the issue of Wood taken in concert with Hinson to be moot.

Therefore, it is respectfully submitted that because the cited patent does not in fact constitute prior art for the present invention, a prima facie case of obviousness does not exist. Based on the above, and the referenced Affidavit Under 37 C.F.R. 1.131, reconsideration and withdrawal of the 35 U.S.C. 103 rejection is respectfully requested and allowance of the claims at an early date is solicited.

Petition Under 37 C.F.R. § 1.182:

Included herewith is a courtesy copy of a petition under 37 C.F.R. § 1.182, to change the order of the named inventors of the instant patent application. This petition is being filed simultaneously herewith under separate cover.

Attachment:

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Art Made of Record:

The prior art made of record and not applied has been reviewed, and Applicants agree with the Examiner that it does not defeat the patentability of the present invention.

Leave to Delay Treatment of Formal Objections Until Allowable Subject Matter is Indicated:

In accordance with 37 C.F.R. 1.111, it is hereby requested that any objections or requirements not fully treated and set forth in the outstanding Office Action that relate to form and are not necessary to further consideration of the now pending claims be held in abeyance until allowable subject matter is indicated.

CONCLUSION

In view of the above amendments and remarks, it is submitted that instant Claims 1- 24 are in condition for allowance. Reconsideration and withdrawal of the rejections and objections are respectfully requested and allowance of the claims at an early date is solicited.

ATTACHMENT:

Affidavit Under 37 C.F.R. 1.131

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Helen G. Galus".

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

23. (Amended) The process of claim 1, wherein the catalyst formed by said process is used for the oxidation of carbon monoxide.

24. (Amended) The process of claim 1, wherein the catalyst formed by said process is used for the oxidation of volatile organic compounds.